

REMARKS

The original application was filed on January 23, 2004 with claims 1-20. The first office action on the merits of the application (First Office Action) was mailed to the applicant's attorney on March 21(?), 2005. Applicant's attorney filed a response to the First Office Action on May 15, 2005, canceling claims 1-20 and adding new claims 21-36.

The Examiner mailed a second office action on the merits on September 29, 2005 (Second Office Action). The Examiner rejected claims 21-27, 30, and 32-35 under 35 U.S.C. 102 as being anticipated by U.S. Patent No. 5,713,077 issued to Hembrecht. The Examiner also rejected claim 29 under 35 U.S.C. 103(a) as being unpatentable over Hembrecht. The Examiner also rejected claims 28, 31, and 36 as being unpatentable over Hembrecht in view of U.S. Patent No. 6,370,692 issued to Duyn.

In a telephone conversation between the Applicant's attorney and the Examiner on October 12, 2005, Applicant's attorney understood the Examiner to state that the independent claims 21, 27 and 32 would be allowable if they were amended to contain a more explicit definition of a head-and-face cover. Evidently, the Applicant's attorney had misunderstood what the Examiner was saying and the Examiner only intended to indicate that the proposed amendments to the claims would remove the 102 rejection based on Hembrecht.

Applicant filed a Request for Continued Examination, along with a Preliminary Amendment on October 29, 2005, and a Supplemental Preliminary Amendment on November 21, 2005. The Examiner mailed an office action dated January 26, 2006 (RCE First Office Action) rejecting claims 21-30 and 32-36 under 35 U.S.C. 103(a) as being

unpatentable over Way. Claim 31 was rejected under 35 U.S.C. 103(a) as being unpatentable over Way in view of Duyn.

Amendments to the Specification

In the RCE First Office Action the Examiner stated that the Original Application had a duplicate page 10 and was missing page 12. The deletion of paragraphs [0046] through [0049] in the published patent application eliminates the duplication of page 10 of the Original Application. The new paragraph added after paragraph [0057] merely makes explicit that which was implicit in FIGS. 1-4, and thus does not constitute new matter.

A copy of the specification, with all amendments made is attached as Appendix A. This copy of the specification is necessarily a reconstruction of the Original Application, because the Examiner represented that the Original Specification had a duplicate page 10 and was missing page 12.

The only previous amendment made to the specification was that the word “clasp” replaced the word “hasp” in paragraph [0038].

Amendment to the Claims

On page 2 of the RCE First Office Action, the Examiner correctly noted that for claim 36, the term “head-and-face cover” should be replaced by the term “ski mask”

The Applicant also notes that on the Supplementary Preliminary Amendment Accompanying the Request for Continued Examination, the Applicant mistakenly labeled claim 29 as being original. Claim 29 should have been labeled “Previously amended” and this mistake has been corrected.

Section 103 Rejections

In the First RCE Office Action, the Examiner rejected claims 21-30 and 32-36 under 35 USC 103(a) as being unpatentable over Way. Specifically, the Examiner suggests that the location of the head-and face cover in the hood is arbitrarily made. This is simply not the case for several reasons.

First, when the head-and-face cover is attached to the hood inside the hood, the position of a portion of the head-and-face cover can be made slightly higher by partially raising the hood. This improves the accessibility of the head-and-face cover when the wearer reaches behind the neck to deploy the head-and-face cover. The hood is generally easier to grasp than the head-and-face cover because the hood extends above a wearer's shoulders. When the head-and-face cover or head sock of Way is positioned behind the wearer's back and stuffed in a pocket, the head-and-face cover is difficult for the wearer to reach.

Secondly, if the head-and-face cover is placed in a pocket attached to a back or front portion of the garment as disclosed by Way, the head-and-face cover creates a lump on the back or front of the garment. This lump can cause tightness of the garment fit and discomfort for the wearer of the garment. This is particularly true when the lump is on the back and the wearer is sitting down and leaning back against a chair back or other vertical surface. When the lump formed by the head-and-face cover is located in the hood of the garment, the position of the lump is controllable because, to sit down, the wearer may simply manually grab the hood, slightly raise the hood (which pivots from around the collar), lean back and then release his grip on the hood. Where the pocket is

attached to a body portion of the garment, as disclosed by Way, the position of the lump is fixed and the lump's position is not controllable by the wearer.

Thirdly, one aspect of the claimed invention is the recognition that placing a pocket on a front portion or a back portion of the garment and then stuffing the head-and-face cover into the pocket creates the uncomfortable lump. Locating the pocket in the hood and attaching the head-and-face cover to the hood lessens this discomfort. The recognition of a source of a problem may result in a patentable invention despite the fact that the solution to the problem is obvious once the source of the problem is recognized.

See *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 U.S. 45 (1923).

Because Way does not disclose the problem of having a lump when the head sock is stored in the storage pocket, the independent claims 21, 27 and 32 could not be obvious with respect to Way.

For the foregoing reasons, independent claims 21, 27 and 32 when taken as a whole, would not have been obvious to a person of ordinary skill in the art at the time the invention was made. Thus, claims 21, 27 and 32 are allowable. Claims 22-26 depend from claim 21 and are allowable because claim 21 is allowable. Claim 28-31 depend from claim 27 and are allowable because claim 27 is allowable. Claim 33-36 depend from claim 32 and are allowable because claim 32 is allowable.

With regard to claim 28, wherein at least one of the garment, pocket, the hood and the head-and-face cover are water impermeable, Way does not teach that any part of the snowboarding jacket is in fact water impermeable. Rather Way merely recites that the "jacket shell, collar shell and hood shell can be made of any suitable material." Column 3, lines 14-15. The Examiner improperly infers the jacket is water impermeable because

it is to be used for snowboarding and skiing. Similarly, the Examiner has improperly inferred that the jacket is waterproof in rejecting claim 36.

For these reasons, the Applicant believes that the claims are now in condition for allowance and urges that the claims be allowed. If the Examiner has any questions about any aspect of the present application, she may call the applicant's attorney at the below listed telephone number.

Respectfully submitted,

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